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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/809,268	03/16/2001	Jean-Louis H. Gueret	5725.0869-02	5334

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EXAMINER

ROBERT, EDUARDO C

ART UNIT PAPER NUMBER

3732

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/809,268

Applicant(s)

GUERET, JEAN-LOUIS H.

Examiner

Eduardo C. Robert

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-222 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 136, 137, 146, 148-152, 156, 161, 163, 174, 175, 179, 189 and 190 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/807,276.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Continuation of Disposition of Claims: Claims withdrawn from consideration are 23-135, 138-145, 147, 153-155, 157-160, 162, 164-173, 176-178, 180-188 and 191-222.

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Species IV, i.e. Figure 4, in Paper No. 8 is acknowledged.

Also, it is acknowledged that applicant believes claims 23-34, 36-39, 41-62, 64-69, 71, 72, 82-108, 110-115, 117, 118, 128-154, 156-161, 163, 164, 174-203, 205, and 214-222.

It is noted that after further consideration of claims 23 and 24, it was concluded by the examiner that these claims are **not generic** to all the species, and they do not read on the elected Species IV, i.e. Figure 4. With regard to claim, claim 23 requires that the material of the gripping portion covering the second end of the flexible support be impervious to a cosmetic product and as disclosed the only material being described as impervious is material 16b which in the Species of Figure 4 is not covering a second end of the flexible support which is part of the gripping portion 6. Actually this claim 23 appears to be directed to the embodiment of non-elected Species VII, Figure 7. With regard to claim 24, claim 24 requires that the flexible support be cardboard and the Species IV, Figure 4 is not disclosed or shown as having a cardboard flexible support. Moreover, non-elected Species I, i.e. Figure 1, is the only Species disclosed as having a cardboard flexible support.

Also, comparison of the claims with Species IV, i.e. Figure 4, and the specification shows, however, that the Species IV, i.e. Figure 4, does not have a tuft of bristles coupled to the first end of the support as required by claim 25. Furthermore, the Species IV, i.e. Figure 4, does not shown or is specifically disclosed as having foam as the flexible material as require by claim

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26; or as having a gripping portion comprising a second end of the support and at least one layer of a flexible material covering the second end and the material being impervious to a product to be applied as required by claim 29; or as having at least one application portion and a gripping portion being asymmetrical with respect to one another as required by claims 33, 34, and 39; or as having a gripping portion having a visual difference from the applicator portion as required by claims 43 and 90; or as having a flexible support comprising cardboard, plastic, leather, and foam as required by claim 138; or as having a flexible support comprising a material of cardboard and leather as required by claim 139; or as having an application portion comprising one of a tuft of bristles, a pencil brush, a feather, a foam material, a sponge material and a baize material as required by claim 140; or as having a first spongy flexible material comprising closed-cell foam as required by claim 141; or as having a first spongy flexible material chosen from polyurethane, polyester, polyether, polyvinyl chloride, and polyethylene as required by claim 142; or as having a first spongy flexible material comprising one of flocking, a fabric layer covering, and a silicone layer covering as required by claim 143; or as having a first spongy flexible material impregnated with at least one active cosmetic agent as required by claim 144; or as having a first spongy flexible material identical to a second spongy flexible material as required by claim 147; or as having at least two of the layers of a same material as required by claim 153; or as having a flexible support having a material chosen from cardboard and leather as required by claim 154; or as having a gripping portion including at least one of a different shape, a different size, and a different width than the application portion as required by claim 157; or as having a gripping portion including a different shape than the application portion as required by claim 158; or as having a gripping portion and an application portion that are

asymmetrical relative to one another as required by claim 60; or as having a flexible support that is spoon-shaped as required by claim 164; or as having cosmetic product impregnated on the application portion as required by claim 176; or as having a cosmetic product which is one of eye shadow, cheek blusher, make-up foundation, eyeliner, nail-care product, liquid lip rouge and loose powder as required by claim 177; or as having an eye makeup product and the surface region being an eyelid as required by claim 178; or as having the step of deforming the layer of the first spongy flexible material with one of the finger and thumb during the gripping as required by claim 180; or as having the step of flexing the flexible support during transferring as required by claim 181; or as being used in a method of reducing pressure exerted on skin during use of an applicator to apply a cosmetic product as required by claim 184; or as having a flexible support with a first end which is a flexible handle, moreover, this appears to be new matter in this continuation application.

It is noted that claims 27, 28, and 30-32 depend from claim 23; claims 36-38 depend from claim 34; claims 41 and 42 depend from claim 33; claims 44-62, 64-69, 71, 72, 82-89, 182, 185, and 186 depend from claim 43; claims 91-108, 110-115, 117, 118, 128-135, 183, 187, and 188 depend from claim 90; claim 145 depends from claim 144; claim 159 depends from claim 158; and claims 192-203, 205, and 214-222 depend from claim 191.

Claims 23-135, 138-145, 147, 153-155, 157-160, 162, 164-173, 176-178, 180-188, and 191-222 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected Species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 136, 137, 146, 148-152, 156, 161, 163, 189, 190, 174, 175, 179 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 136, line 8, the phrase "spongy flexible material" is indefinite because it is unclear how the materials other than sponge have to resemble the sponge to satisfy the limitations of the claim. *Ex parte Caldwell*, 1906 Comm'r Dec. 58. It is noted that applicant appears to use the phrase "spongy" to indicate the material used is a soft material and will be considered as such for examination purposes throughout the claims.

In claim 189, lines 1 and 2, "the gripping portion is configured in the form of a handle" is indefinite because it is unclear what applicant means by "configured in the form of a handle".

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 136-151, 163, 189, and 190 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,913,318. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between the claims of the application and the claims of the patent lies in the fact that the patent claims include more elements and is more specific. Thus, the invention of the application claims are in effect a “species” of the “generic” invention of the patented claims. It has been held that the generic invention is “anticipated” by the “species”. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993). Since the claims of the application are anticipated by the claims of the patent, they are not patentably distinct from the claims of the patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 136, 137, 146, 148,-152, 156, 161, 163, 174, 175, 179, and 189, 190 rejected under 35 U.S.C. 102(b) as being anticipated by Bloch, et al. (Reference U.S. Pat. 3,179,108 on PTO-1449).

Bloch, et al. disclose an applicator comprising an elongated flexible support including in cross-section a first planar surface and a second planar surface (see Figure 3). The first and second planar surface facing away from one another. The applicator also includes an application

portion at a first end of the flexible support 16 and a gripping portion at a second end of the flexible support opposite the first end (see Figure 1). The applicator includes a layer of a spongy flexible material on the first planar surface at the gripping portion the material has a greater flexibility than the flexibility of the support. The first and second planar surfaces are parallel to one another. The flexible support further comprises layer of spongy flexible material on both gripping portion and application portion first and second planar surface (see Figure 1). The layers of spongy flexible material appears to be thicker than support. Bloch, et al. disclose that the applicator can be used to apply cosmetics.


Applicant is reminded that an anticipation under 35 U.S.C. 102(b) or 102(e) is established when a single prior art reference discloses, either expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data System, Inc.*, 730 F.2d 1440, 221 USPQ 385 (Fed. Cir. 1984). Furthermore, it is well settled that the law of anticipation does not required that the reference teach what appellant is teaching or has disclosed, but only that the claims on appeal “read on” something disclosed in the reference, i.e. all limitation of the claims are found in the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 218 USPQ 781 (Fed. Cir. 1083). Moreover, it is not necessary for the applied reference to expressly disclose or describe a particular element or limitation of a rejected claim word for word as in the rejected claim so long as the reference inherently discloses that element or limitation. *Standard Havens Products Inc. v. Gencor Industries Inc.*, 953 F.2d 1360, 21 USPQ 2d. 1321 (Fed. Cir. 1991).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eduardo C. Robert whose telephone number is 703-305-7333. The examiner can normally be reached on Monday-Friday, 9:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin P. Shaver can be reached on 703-308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.


Eduardo C. Robert
Primary Examiner
Art Unit 3732

E.C. Robert
October 20, 2002